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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,064	02/18/2004	Jean-Marc Frances	RN98131D1	1850

7590 05/31/2006

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INTELLECTUAL PROPERTY DEPT.
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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,064

Applicant(s)

FRANCES, JEAN-MARC

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 17 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/806,629.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

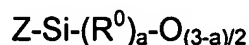
Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/18/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim/Specification Objections

Claims 12 through 19 are objected to for numerous reasons as follows:

(a) Applicant has, in the base claim, represented the mandatory unit of the silicone polymer as,



wherein R⁰ is a monovalent substituent that is bonded directly to silicon. As the unit is depicted, R⁰, itself, appears to be a repeat unit numbering zero-to-two and, further, seems to be also bonded to an oxygen atom. The same formula is provided on page two of the Specification. In each instance, the formula should be amended such that it is unambiguous as to what the connectivity of the structural units. For example, R⁰ could be drawn directly above or below the silicon atom.

(b) Under the heading of compound (4), Applicant refers to a cationic borate entity when it is clear from that which follows that the radicals portrayed are the borate residues themselves. Correction is required.

Claim 15 is further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 15 actually contemplates more embodiments of the photoinitiator component than does claim 12.

Claim Rejections - 35 USC § 112

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "using" is imprecise as an indication of a particular manipulation of the claimed composition insofar as it does not clearly define the action taken on said composition. It is suggested that Applicant should consider substituting the phrase d' shaping and curing" for "using" to add clarity to the claimed method.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Priou et al., U.S. Patent # 5,703,137. Priou et al. discloses an onium borate salt (column 4, line 29 through column 5, line 9) that is structurally equivalent to those of the instant invention as a photoinitiator for crosslinking epoxy-functionalized silicone oils (column 6, lines 59-63). A light radiation absorption profile is not expressly reported for these materials.

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Nonetheless, it is noted that Applicant has admitted on page 21 of the disclosure that thioxanthone derivatives are among those compounds that will inherently satisfy the requirement of having a residual light absorption of between 200 and 500 nm.

Furthermore, Priou instructs in column 8, lines 30-32 that the irradiation wavelength should be between 200 and 400 nm hence the other photosensitizers named therein will also inherently absorb energy in the wavelength range set forth by the Applicant.

Equivalent polyaromatic photosensitizers including anthracene, thioxanthone, etc. are contemplated in column 7, lines 37-42.

Applicant refers to their invention as a "dental" composition, or a composition that may be employed in various oral applications. In this connection, they have claimed a "dental" filler as one of the essential components of their invention. According to section 2111.02 of the MPEP, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent

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in an old product defined by the remainder of the claim). Insofar as many of the materials contemplated on page 26 and 27 are merely ubiquitous fillers employed in myriad applications, the claim will be anticipated provided that the reference discloses the addition of similar materials. Hence, the failure of the reference to mention dental fillers notwithstanding, claim 12 is anticipated because fumed silica is identified both by Applicant on page 27 and by Priou in column 7, lines 43-50 as a useful filler compound.

As for claim 14, several of these radicals are duplicated in column 6 of the reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are rejected on the ground of nonstatutory double patenting over claims 1-4 of U. S. Patent No. 6,747,071 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. There is essentially full overlap of these claims, the only thing distinguishing them being that claim 1 of the patent recites a select couple thioxanthenes that are embraced by the more broadly encompassing description of thioxanthenes in the present application.

Allowable Subject Matter

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if (i) the objections of record were to be suitably addressed and (ii) the claim was rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In the parent Application, the Examiner had also cited the combined teachings of Weinmann et al. and Castellanos et al. as being especially germane to some of the claims originally presented in that Application. Those claims had not been so particular as to the identity of the photoinitiator and photosensitizer as are the present claims which explains why the aforementioned references do not represent a foundation for rejection in the present case.

The Examiner had attempted to, in carrying out a search of the present invention, locate mention of the claimed embodiments of the photoinitiator or photosensitizer alone

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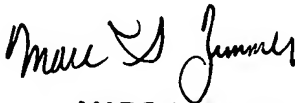
with an epoxy/oxetane/vinyl-ether functional compound and then determine a specific motivation to add the other per the teachings of a second reference but this approach was unsuccessful in providing additional grounds for rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 27, 2006


MARC S. ZIMMER
PRIMARY EXAMINER